

REMARKS

Claims 26-33 are pending in the present application. Claims 26-33 have been newly added. Claims 1-25 have been cancelled without prejudice or disclaimer to the subject matter recited therein.

Newly added claim 26 corresponds to the subject matter of cancelled claims 1 and 23. New claim 26 is directed to "A reactive fine particle, comprising: at least one latent curing agent selected from the group consisting of a urea derivative, an imidazole, a dicyandiamide (DICY), a mixture thereof and a precursor thereof; and at least one inorganic inert particle selected from the group consisting of a metal oxide, a mineral filler, a natural filler or a mixture thereof, the at least one inorganic inert particle having a specific surface area in the range of about 10 to about 50 m²/g, wherein the latent curing agent is entrapped, immobilized, encapsulated, soaked, doped or bonded into the inner portion of the inorganic inert particle or the latent curing agent is coated on the outer rim of the inorganic inert particle, wherein a weight ratio of the at least one latent curing agent to the at least one inert particle is in the range of from 0.01:100 to 50:100, and wherein the reactive fine particle has a maximal size of less than 2 microns." Support for new claim 26 can be found, for example, in cancelled claims 1 and 23, as well as throughout the specification as originally filed.

Newly added claim 27 corresponds to the subject matter of cancelled claim 2. New claim 27 is directed to "The reactive fine particle of claim 26, wherein the at least one latent curing agent is configured to initiate cross linking

and/or polymerization of thermoset polymers” Support for new claim 27 can be found, for example, in cancelled claim, as well as throughout the specification as originally filed.

Newly added claim 28 corresponds to the subject matter of cancelled claim 17. New claim 28 is directed to “The reactive fine particle of claim 26, further comprising a central inert particle which comprises the at least one inorganic inert particle coated by a layer comprising the at least one curing agent.” Support for new claim 28 can be found, for example, in cancelled claim 17, as well as throughout the specification as originally filed.

Newly added claim 29 corresponds to the subject matter of cancelled claim 18. New claim 29 is directed to “The reactive fine particle of claim 26, wherein the at least one inorganic inert particle comprises a component selected from the group consisting of BaSO₄ (barium sulfate), CaSO₄, CaCO₃, talc, kaolin, mica and glass” Support for new claim 29 can be found, for example, in cancelled claim 18, as well as throughout the specification as originally filed.

Newly added claim 30 corresponds to the subject matter of cancelled claim 19. New claim 30 is directed to “The reactive fine particle of claim 26, wherein the at least one latent curing agent is DICY.” Support for new claim 30 can be found, for example, in cancelled claim 19, as well as throughout the specification as originally filed.

Newly added claim 31 corresponds to the subject matter of cancelled claim 20. New claim 31 is directed to “The reactive fine particle of claim 30, wherein the at least one inorganic inert particle comprises barium sulfate.”

Support for new claim 31 can be found, for example, in cancelled claim 20, as well as throughout the specification as originally filed.

Newly added claim 32 corresponds to the subject matter of cancelled claim 21. New claim 32 is directed to "The reactive fine particle of claim 26, wherein the at least one latent curing agent is in a crystalline form." Support for new claim 32 can be found, for example, in cancelled claim 21, as well as throughout the specification as originally filed.

Newly added claim 33 corresponds to the subject matter of cancelled claim 22. New claim 33 is directed to "The reactive fine of claim 26, wherein the at least one latent curing agent is adapted for activation at temperatures above 120°C." Support for new claim 33 can be found, for example, in cancelled claim 22, as well as throughout the specification as originally filed.

No new matter has been added

In view of the following, further and favorable consideration is respectfully requested.

- I. At page 3 of the Official Action, claims 1-2 and 17-23 have been rejected under 35 USC § 102(e) as being anticipated by, or in the alternative as being obvious under 35 USC § 103(a) over Ahsan (US Patent No. 6,822,341).***

The Examiner asserts several elements of claims 1-2 and 17-23 are disclosed in Ahsan. Additionally, the Examiner indicates that "Ahsan can be said to differ from applicant's claimed invention in that there does not seem to be a direct teaching of a curative that comprises a catalyst agent that falls within applicant's claimed curing agents." See page 4 of the Official Action. However,

the Examiner asserts that it would have been obvious to one having skill in the art to use Ahsan's disclosure to imadazole compounds to use imadazoles in the production of the curative product.

In view of the cancelation of claims 1-2 and 17-23, this rejection has been rendered moot. Additionally, Applicants respectfully submit that new claims 26-33 are neither anticipated nor rendered obvious by Ahsan.

Anticipation under 35 USC § 102 requires that a single prior art reference teach each and every limitation of the claimed invention and enable one skilled in the art to make the anticipating subject matter. See *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558 (Fed. Cir. 1996).

"For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art...The reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." See *In re Spada*, 911 F.2d 705 (Fed. Cir. 1990). Although the disclosure requirement presupposes the knowledge of one skilled in the art, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. *Id.*

"Summary judgment of inherency anticipation was improper because of a material fact issue whether a prior art reference's process necessarily produced the claimed invention's features." See *Continental Can Company USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). "Consistent with the law of inherent anticipation, an inherent property must necessarily be present in the

invention described by the count, and it must be so recognized by persons of ordinary skill in the art.” *Id.* “The mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation.” *See Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048 (Fed. Cir. 1994).

In *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043 (Fed. Cir. 1995), the court held that the patent claim in suit was not inherently anticipated where the prior art process produced alternate forms. More specifically, the Glaxo court held that Form 2 of ranitidine was not “inherently and necessarily” produced in Example 32 of Glaxo’s patent. The question is whether the missing element “is necessarily present in the thing described in the reference and that it would be so recognized.” *See Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373 (Fed. Cir. 2002). Regarding recognition, the question is whether one skilled in the art would read the prior art reference as inherently disclosing the invention. *Id.*

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *See In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). “Occasional results are not inherent.” *See Mehl/Biophile International Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999). “A reference includes an inherent characteristic if that characteristic is the natural result flowing from the reference’s explicitly explicated limitations.” *See Continental Can Company USA, Inc., supra.*

Regarding obviousness, to establish a *prima facie* case of obviousness, the Examiner must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

Applicants respectfully submit that Ahsan does not teach every element of new claims 26-33, either expressly or inherently, as required for anticipation under 35 USC § 102(e). Additionally, Applicants submit that Ahsan does not teach or suggest each and every element of claims 26-33 as required by *In Re Wilson*.

New claim 26 is directed to "A reactive fine particle, comprising: at least one latent curing agent selected from the group consisting of a urea derivative, an imidazole, a dicyandiamide (DICY), a mixture thereof and a precursor thereof; and at least one inorganic inert particle selected from the group consisting of a metal oxide, a mineral filler, a natural filler or a mixture thereof, the at least one inorganic inert particle having a specific surface area in the range of about 10 to about 50 m²/g, wherein the latent curing agent is entrapped, immobilized, encapsulated, soaked, doped or bonded into the inner portion of the inorganic inert particle or the latent curing agent is coated on the outer rim of the inorganic inert particle, wherein a weight ratio of the at least one latent curing agent to the at least one inert particle is in the range of from 0.01:100 to 50:100, and wherein the reactive fine particle has a maximal size of less than 2 microns." Claims 27-33 depend, either directly or indirectly, from claim 26.

In contrast, Ahsan is directed to a latent catalyst particularly for epoxy molding compositions. The latent catalyst is in the form of a curative represented by a combination of an inorganic-based carrier having an activated surface and a catalyst compound including a moiety capable of accelerating curing of the epoxy resin, such as the reaction product of silica and DBU. The activated surface of

the inorganic-based carrier includes reactive surface groups capable of bonding to the moiety through a hydrogen bond, and also includes a high surface area porous surface, such that the catalyst compound is sorbed on the activated surface. See Ahsan, abstract. However, Ahsan does not teach or suggest a reactive fine particle which comprises ***at least one inorganic inert particle having a specific surface area in the range of about 10 to about 50 m²/g***, as recited by the presently pending claims.

In fact, ***as disclosed in the present application at paragraph 27 of the published present application, "the most favorable powder is the one characterized by a specific surface area ranging between 10 and 50 m²/g;*** since it is non-abrasive, and hence avoid damage to application tooling, especially to an ink-jet print head." See paragraph 27 of the published present application. In contrast, ***Ahsan describes an inorganic based carrier having "a surface of 200-1000 m²/g, more desirably 200-600 m²/g, and more desirably 200-300 m²/g."*** See Ahsan at column 5, lines 26-33.

Therefore, it is submitted that Ahsan fails to teach each and every element of new claims 26-33 as required for anticipation under 35 USC § 102 (b). Additionally, it is submitted that Ahsan fails to teach or suggest every element of new claims 26-33 as required to establish *prima facie* obviousness under 35 USC § 103(a). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

II. At page 4 of the Official Action, claims 1-2 and 17-23 have been rejected under 35 USC § 103(a) as being unpatentable over Correll et al. (US Patent Application Publication No. 2004/0230008).

The Examiner asserts that it would have been obvious to use the disclosure of Correll et al. as motivation to make a powdery component that comprises one of Applicant's claimed curing agents..

In view of the cancelation of claims 1-2 and 17-23, this rejection has been rendered moot. Additionally, Applicants respectfully submit that new claims 26-33 are not rendered obvious by Correll et al.

To establish a *prima facie* case of obviousness, the Examiner must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."

(*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

Applicants respectfully submit that a *prima facie* case of obviousness has not been established because Correll et al. do not teach or suggest every element of new claims 26-33, as required by *In re Wilson*.

As discussed claim 26 is directed to "A reactive fine particle, comprising: at least one latent curing agent selected from the group consisting of a urea derivative, an imidazole, a dicyandiamide (DICY), a mixture thereof and a precursor thereof; and at least one inorganic inert particle selected from the group consisting of a metal oxide, a mineral filler, a natural filler or a mixture thereof, the at least one inorganic inert particle having a specific surface area in the range of about 10 to about 50 m²/g, wherein the latent curing agent is entrapped, immobilized, encapsulated, soaked, doped or bonded into the inner portion of the inorganic inert particle or the latent curing agent is coated on the outer rim of the inorganic inert particle, wherein a weight ratio of the at least one latent curing agent to the at least one inert particle is in the range of from 0.01:100 to 50:100, and wherein the reactive fine particle has a maximal size of less than 2 microns." Claims 27-33 depend, either directly or indirectly, from claim 26.

In contrast, Correll et al. is directed to a powder composition in multiple separate parts comprising one or more than one resinous powder component in one or more than one part and, for each resin component, one or more than one powder, liquid or gaseous curing agent component in one or more than one separate part, wherein the average particle size ratio of each resinous powder component to its curing agent powder or droplet component ranges from 1.3:1 to 60:1 to insure the attraction of the resin and its curing agent to one another. See Correll et al., abstract. However, unlike the presently pending claims, Correll et al. do not teach or suggest a reactive fine particle which comprises ***at least one inorganic inert particle having a specific surface area in the range of about 10 to about 50 m²/g***, as recited by the presently pending claims.

In view of the foregoing, it is submitted that Correll et al. fail to teach or suggest every element of new claims 26-33 as required to establish *prima facie* obviousness under 35 USC § 103(a). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

III. At page 5 of the Official Action, claims 1-2 and 12-23 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 23-30 of copending Application No. 10/757,175.

The Examiner asserts the presently pending claims are not patentably distinct from claims 29-30 of the copending application.

Applicant respectfully request that this rejection be held in abeyance until an indication of allowable claims in this, or the co-pending application, is given

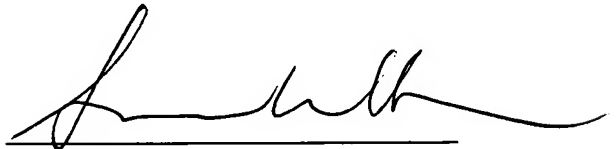
CONCLUSION

In view of the foregoing, Applicants submit that the application is in condition for immediate allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

THE NATH LAW GROUP

A handwritten signature in black ink, appearing to read 'Gary M. Nath', is written over a horizontal line.

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